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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 08/952,001
Filing Date: November 07, 1997
Appellant(s): CARR, RONALD L

Garth Janke
For Appellant

EXAMINER'S ANSWER

MAILED

JAN 31 2003

GROUP 3600

This is in response to the appeal brief filed October 8, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3676

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 55 and 85, which stand rejected.

Upon further consideration, claims 56-58, 60-84, and 88-92 are allowed.

Claims 59, 86, and 87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct. For brevity, however, a summary of claims 55 and 85, specifically, follows:

Claim 55 is drawn to a gasket for providing a seal at a joint between a pair of pipe flanges. The gasket comprises a first strip, second strip, and at least one spoke each formed of the same sealing material. The first and second strips are formed in loops. The second strip has an inner periphery that is greater than the outer periphery of the first strip. The at least one spoke

Art Unit: 3676

extends between the first strip and second strip and remaining spaces therebetween are substantially void. See, for example, Figure 4.

Claim 85 is drawn to a gasket for providing a seal at a joint between a pair of pipe flanges. The gasket comprises a first strip, second strip, and at least one spoke each formed of the same sealing material. The first and second strips are formed in loops. The second strip has an inner periphery that is greater than the outer periphery of the first strip. The outer periphery of the first strip is circular and the outer periphery of the second strip is substantially square. The at least one spoke extends between the first strip and second strip. See, for example, Figures 14 and 15.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: regarding issue 2, upon further consideration, claims 60-62, 66-69, 73-78, and 82-84 are allowed, and claim 87 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The examiner agrees with issues 1 and 3.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because there is no statement as to why claims 55 and 85 should not be treated together. In that absence, claims 55 and 85 are considered to stand and fall together.

Art Unit: 3676

(8) Claims Appealed

A substantially correct copy of appealed claims appears on pages 27-30 of the Appendix to the appellant's brief. The minor errors are as follows: claim 82 (which has been allowed) is submitted in the incorrect form. In the Appendix, the claim has been submitted in independent form. The claim actually is a dependent claim as last amended in paper # 16.

Claim 85 contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim 85 is correctly written in the Appendix to the Examiner's Answer.

(9) Prior Art of Record

RE. 11,858	Merwarth	9-1900
1,245,002	Mastin	10-1917

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 55 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merwarth (Re. 11,858).

Merwarth discloses a gasket (in Fig. 3) for providing a seal at the joint between a pair of pipe flanges D' and E comprising a first strip A formed in a loop having an outer periphery, a second strip F formed in a loop having an outer periphery greater than the first strip's, and at least one spoke C extending between the first and second strips wherein remaining spaces therebetween are substantially void. The first strip, second strip, and spoke are all formed of a sealing material (soft metal, see page 2, lines 15, 19-20, and 29-33). While Merwarth does not specify that the "soft metal" of A, F, and C are the same soft metal, it is considered inherent that they are since the strips/spoke function as seals (see page 2, lines 21-24 and 31-33).

Further, it is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, (CCPA 1960). Using the same material would also provide ease in manufacturing considerations. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the first and second strips and the spokes of the same material as a matter of choice in design.

Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin.

Mastin discloses a gasket comprising a first strip g', a second strip j, and at least one spoke k of sealing material (see Figure 3). The strips and spokes are formed of the same sealing material and "are designed to produce a hermetic seal" (page 1, lines 23-27). Mastin does not disclose that the outer periphery of the second strip is substantially square. Making the outer periphery of the second strip substantially square is considered a design choice as applicant has not stated that using a square rather than a circle solves any stated problem or is for any particular purpose. Further, it appears that the circular shape of Mastin would perform equally as well. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the second strip with a square shape as a matter of choice in design.

(11) Response to Argument

Regarding the arguments toward the 35 U.S.C. 102(b)/103(a) rejection for claim 55, Appellant submits that the rejection is inconsistent with the teachings of Merwarth. Appellant submits that inner ring A is formed of a softer metal than spokes C because outer ring B, from which spokes C are made, is disclosed as being composed of a harder metal than the inner one page 1, lines 66-67. Appellant argues that the rings A and B are different because they have different functions. These arguments are based on structure disclosed for the embodiment in

Art Unit: 3676

Figure 1. However, the rejection is based on the embodiment of Figures 3 and 4. This embodiment features a gasket with an inner strip A to seal near the opening in the pipe, an outer strip F to seal near the outer peripheries of the flanges, and at least one spoke C to seal the bolt-holes (see page 2, lines 11-33). Merwarth specifically states that the spokes C can be made of “soft metal, so that the bolt-holes will be sealed” (page 2, lines 27-31). There is no indication that the soft metal of C should not be as soft as the soft metal of A, as suggested by Appellant. The purpose for the soft metal, as disclosed by Merwarth and acknowledged by Appellant, is to provide a seal where used. Appellant argues that ring B (and therefore spokes C) must be harder than ring A or the gasket will be destroyed because ring B will no longer serve as a “retaining-ring.” The examiner disagrees. A reference cannot be destroyed if the reference teaches that change. Merwarth “teaches” changing the material of spokes C to a soft metal to provide a seal. Even though ring B is disclosed as a harder metal for the embodiment of Figure 1, the spokes C (of Figure 3) are now disclosed as a soft metal because they serve a different function than in the other embodiment.

Regarding Appellant’s statement that “everything stated in Merwarth is consistent with the principle of forming the ring B from a harder material than the ring A for the purpose of providing a gasket having both a soft portion for sealing and a harder (and therefore stronger) retaining portion of retaining the soft ring A against pressure,” the examiner disagrees. Merwarth discloses many embodiments, not all of which include a harder retaining ring (see for example, Figure 5 and page 2, lines 35-38). In fact, Merwarth states the objective is to provide a gasket that is effectively centered on and seals the joint whether the fluids contained therein are “under pressure or not” (see page 1, lines 45-54). Therefore, making the retaining ring B from a

Art Unit: 3676

harder metal is not critical to the functioning of the gasket, especially the gasket of Figure 3.

Further, the examiner submits ring B would still function as a retaining ring when made of the same material as A (and F).

Regarding arguments toward the selection of material/design choice statement, this was provided in the alternative to the 102(b) rejection. As stated in the rejection, Merwarth discloses that the first strip, second strip, and spokes (in Figure 3) are all formed of "a soft metal" for sealing. While Merwarth does not specifically state that the soft metal used for each of the two strips and spoke is the same soft metal, using the same soft metal is considered a design choice. It has been held that selecting a known material based on its suitability for its intended use is not inventive. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In this case, copper, for example (also see page 1, lines 63-64), is a known soft metal that is used for sealing. It would have been obvious for one of ordinary skill in the art at the time the invention was made to use copper as the soft metal for each of the strips and spokes to provide a seal. Further, using the same material would have provided ease in manufacturing considerations. Appellant argues that this argument requires the gasket to be formed integrally. The examiner disagrees. Nowhere has it been proposed that using the same material provides ease in manufacturing considerations because the gasket parts can be made integrally. Even though it could be, the examiner is not implying that it has to be. One of ordinary skill in the art will realize many ways that manufacturing considerations would be simplified by using the same material to do the same function. For example, only one material rather than three separate soft metals would have to be provided. Therefore, making the first strip, second strip, and spokes of the same soft metal is considered a design choice for the reasons stated above. Finally, why, when Merwarth clearly

Art Unit: 3676

discloses that “soft metal” is used for the express purpose of sealing, would one of ordinary skill in the art not use the same soft metal at each location (first strip, second strip, and spokes) to create the seal? Why would one choose three separate soft metals to do the same job?

Regarding the arguments toward the 35 U.S.C. 103 rejection for claim 85, Appellant submits that the rejection fails to give adequate notice of the nature of its ground. The examiner disagrees. The rejection clearly states that making the outer periphery of the second strip substantially square is considered a design choice because there is no statement that using a square rather than a circle solves any stated problem or is for any particular purpose. It has been upheld that changes in shape are considered obvious design choices absent persuasive evidence that the particular shape was significant. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In this case, Appellants arguments are unpersuasive. Appellant argues that the corners are available to protrude from a round pipe flange. Yet, Appellant is arguing features that are not recited in the rejected claim. The claim does not include any limitations regarding the flange shape or size or any gasket features in relation to the flange shape or size. And, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, there also is no criticality supported in the specification as to the shape. Page 16, lines 25-35 of the specification provide the description of the embodiments (Figures 14 and 15) with the square periphery. Clearly, there is no mention of the purpose of the square shape or any problems solved with the square shape. And, there is no description of how that shape relates to a flange. To allow the argued features in would be new matter. Appellant has argued the statement in the rejection that “the circular shape of Mastin would perform equally as well” is a

Art Unit: 3676

mis-statement of fact. The examiner disagrees. For as many environments that Appellant can argue the square shape would be better than the circular shape (e.g. where the corners would protrude from the flange), the examiner can argue as many where the circular shape is just as good (e.g. where the flange perimeter is greater than the gasket perimeter). The fact remains that these are limitations not recited in the rejected claim. The design choice rejection is proper for the invention as claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Anthony Knight

SPE

Art Unit 3676

AP

January 27, 2003

Conferees

AK, HS

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APPENDIX

85. A gasket for providing a seal at the joint between a pair of pipe flanges for connecting one flange to the other, comprising:

a first strip of a material adapted for sealing and formed in a loop having an outer periphery;

a second strip of said sealing material formed in a loop and having an outer periphery and an inner periphery greater than said outer periphery of said first strip; and

at least one spoke of said sealing material extending between said first strip and said second strip, and wherein said outer periphery of said first strip is substantially circular and said outer periphery of said second strip is substantially square.